

Remarks

By this Amendment, claims 1 and 5 have been amended to recite with greater particularity that the paint residue is extracted from a paint waste stream that is free of isocyanate. The paint waste stream free of isocyanate, such as one originating from one-component paint compositions, is readily distinguished from a paint waste stream originating from two-component paint compositions, such as one from Hovestadt et al. (US Patent 5,453,460, hereinafter *Hovestadt*). With this Amendment, the claims are now particularly directed to a waste paint stream free of isocyanate, such as waste washes from one-component paint compositions, support for the claim amendments is found in the original specification directed to paints in general.¹ No new matter is introduced by the claim amendments.

This application has been carefully reviewed in light of the Office Action dated April 10, 2009, hereinafter "the Office Action." At the time of the Office Action, claims 1-9 and 11-14 were rejected. Applicant respectfully requests reconsideration of the application in view of the claim amendments and the following remarks.

Remarks Directed to Claim Rejections under 35 U.S.C. §112

Claims 1-9 and 11-14 are rejected under 35 U.S.C. §112 as the Examiner deems the phrase "being substantially free of cross-linking on its own" as lacking support in the original specification. The phrase has been deleted off of the claims. Withdrawal and reconsideration of this rejection is solicited.

Remarks Directed to Claim Rejections under 35 U.S.C. §102(b)

Claims 1-3 and 11 stand rejected under 35 U.S.C. §102(b) over Hovestadt (U.S. Patent 5,453,460; hereinafter *Hovestadt*). Applicants' remarks directed to this rejection have

¹ See for instance page 1 of the original specification at lines 1-5.

been presented previously and are not reproduced herein. However, Applicant, through his counsel, submits the following additional remarks in view of the instant claim amendments.

The independent claim 1 as amended relates to a paint residue extracted from a paint waste stream free of isocyanate. *Hovestadt*, as the Examiner agrees,² teaches a process for reusing the overspray obtained from two-component polyurethane coating compositions which contain isocyanate. Thus, *Hovestadt* fails to teach or suggest the at least aforementioned claim limitation recited in the independent claim 1. The independent claim 1 and all the claims dependent therefrom are submitted to be patentable over *Hovestadt*. Reconsideration and withdrawal of the rejections to claims 1-3 and 11 is respectfully solicited.

Remarks Directed to Claim Rejections under 35 U.S.C. §103(a)

Applicants' remarks directed to the below-identified claim rejections have been presented previously and are not reproduced herein. However, Applicant, through his counsel, submits the following additional remarks in view of the instant claim amendments.

With respect to the rejection of claim 4 under 35 U.S.C. §103(a) over *Hovestadt* and Moriarty et al. (U.S. Patent 6, 692,670; hereinafter *Moriarty*), claim 4 is submitted to be patentable based on its dependency from claim 1. As set forth above, *Hovestadt* does not teach or suggest the paint residue of claim 1 wherein the paint residue is extracted from a paint waste stream free of isocyanate. *Moriarty* does not cure *Hovestadt's* deficiency. Reconsideration and withdrawal of this rejection to claim 4 is solicited.

With respect to rejections to claims 5-7 and 14 under 35 U.S.C. §103(a) over *Hovestadt* in view of Patzelt et al. (U.S. Patent 5,766,370; hereinafter *Patzelt*), it is noted that the independent claim 5 as amended recites a process relates to placing a paint waste stream in a still wherein the waste stream is free of isocyanate.

² See for instance page 3 of the Office Action dated April 10, 2009.

As set forth above, *Hovestadt* does not teach or suggest a paint residue extracted from a paint waste stream free of isocyanate. *Patzelt* does not cure *Hovestadt*' deficiency. In addition, the Examiner has not set forth for the record remarks³ responsive to *Patzelt* as a teaching away reference and the proposed combination of *Hovestadt* and *Patzelt* as being impermissible, particularly in view of the well-settled law in *In re Wesslau*⁴ and *In re Ratti*.⁵ Applicant respectfully requests such remarks to be made for the record. The independent claim 5 and all the claims dependent therefrom are submitted to be patentable over *Hovestadt* in view of *Patzelt*. Reconsideration and withdrawal of the rejections to claims 5-7 and 14 is respectfully solicited.

Responsive to rejections of claims 8-9 and 13 under 35 U.S.C. §103(a) over *Hovestadt*, *Patzelt*, further in view of Applicant's admission of prior art, notably claims 8-9 and 13 each depend from the independent claim 1. As set forth above, *Hovestadt* does not teach or suggest the paint residue extracted from a paint waste stream free of isocyanate. *Patzelt* fails to cure the defective teachings of *Hovestadt*. Moreover, the Examiner has not set forth how the Applicant's admission would cure the defective teachings in view of the above. For at least these reasons, claims 8-9 and 11, each of which depends from claim 1, are patentable over the proposed combination. Reconsideration and withdrawal of these rejections to claims 8-9 and 13 is solicited.

Responsive to rejection of claim 12 under 35 U.S.C. §103(a) over *Hovestadt*, notably claim 12 is submitted to be patentable due to its dependency from the independent claim 1, which is now believed to be allowable, for at least the same reasons set forth above. Reconsideration and withdrawal of rejections to claim 12 under 35 U.S.C. §103(a) over

³ See for instance pages 8-9 of the Amendment dated February 17, 2009.

⁴ 147 USPQ 391, 393 (CCPA 1965).

⁵ If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Please see also MPEP 2143.01.

Hovestadt is solicited. In addition, the Examiner has not set forth for the record remarks responsive to claim 12's independent ground of patentability stated on pages 10-12 of the Amendment February 17, 2009. Applicant respectfully requests such remarks be made for the record.

Remarks Directed to the Examiner's Arguments

In response to the "Response to Arguments" stated on pages 7-9 of the Office Action dated April 10, 2009, Applicant, through his counsel, respectfully submits the following additional remarks.

The Examiner argues that the limitation of the paint residue "being substantially free of cross-linking on its own" is a new matter. This limitation is deleted off of the claims to advance prosecution.

In response to the Examiner's comments with respect to claim 11, notably *Hovestadt* may have taught adjust spray viscosity, however, *Hovestadt* does not teach diluting a paint residue prior to the addition of a hardner as required in claim 11.

With respect to *Patzelt*, the Examiner continues to regard that discarding a paint residue in the process of reusing a paint solvent as taught in *Patzelt* is the same as saving the paint residue according to the claimed invention. *Patzelt*, as one skilled in the art, was clearly not aware of the claimed process of saving the paint residue as he simply discarded it.

The Examiner argues that the chemical reactions between the isocyanate groups and isocyanate-reactive groups are not easily reversible. Please note that *Hovestadt* uses secondary amines as the isocyanate-reactive groups, which split off at elevated temperatures and hence reverse the isocyanate groups to their un-blocked state.⁶

⁶ See for instance col. 6 of *Hovestadt* at lines 31-35.

The Examiner continues to argue that the claimed limitation of claim 12 is merely a result-effective variable, yet has not commented with articulated reasons on the Applicant's remarks previously set forth in the record,⁷ with particular reference to MPEP 706.02(j). Notably, the Examiner admits *Hovestadt* does not teach the amount of thinning solvent used, nor is there any recognition as to the effect of thinning of the paint residue on the consequential reaction with a hardner.

Conclusion

Applicant does not acquiesce in the Examiner's characterizations of the art. For brevity and to advance prosecution, Applicant may not have addressed all characterizations of the art and reserves the right to do so in further prosecution of this or a subsequent application. The absence of an explicit response by Applicant to any of the Examiner's positions does not constitute a concession to the Examiner's positions. The fact that Applicant's comments have focused on particular arguments does not constitute a concession that there are not other arguments for patentability of the claims. Applicant submits that all of the dependent claims are patentable for at least the reasons given with respect to the claims on which they depend.

Claims 1-9 and 11-14 are pending in the applications. Applicant has made a genuine effort to respond to each of the rejections that all formal and substantive requirements for patentability have been met and that this case is condition for allowance, which action is respectfully requested. If a telephone or video conference would help expedite allowance or resolve any additional questions, such a conference is invited at the Examiner's convenience.

⁷ See for instance pages 10-12 of the Amendment dated February 17, 2009.

The Petition fee of \$65.00 is being charged to Deposit Account No. 02-3978 via electronic authorization submitted concurrently herewith. Please charge any fees or credit any overpayments as a result of the filing of this paper to our Deposit Account No. 02-3978.

Respectfully submitted,

MARK ANDREW ROWEN

By /Junqi Hang/

Junqi Hang
Reg. No. 54,615
Attorney for Applicant

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BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075-1238
Phone: 248-358-4400
Fax: 248-358-3351